REMARKS

Claims 1-15 in the subject application are presently under consideration. Favorable reconsideration of the subject patent application is respectfully requested in view of the comments herein.

I. Election/Restriction Requirement

The Examiner requires restriction to one of the following three groups of claims:

Group I: Claims 1-4, drawn to a method of capturing and providing demographic information concerning a consumer of products to a manufacturer of such products during transactions in which the consumer utilizes a bar code reader and the Internet for product inquiries, classified in class 705, subclass 10.

Group II: Claims 5-12, drawn to a method for a consumer to obtain product information, classified in class 705, subclass 10.

Group III: Claims 13-15, drawn to a method for obtaining consumer demographic information, classified in class 709, subclass 238.

Applicants' representative hereby elects with traverse Group I (claims 1-4) for further prosecution on the merits.

II. Rejection of Claims 1, 2 and 3 Under 35 U.S.C. 103(a)

Claims 1, 2 and 3 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Hudetz, *et al.* (U.S. Patent No. 5,978,773) in view of Powell (U.S. Patent No. 5,887,271). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons.

The combination of Hudetz *et al.* and Powell does not make obvious the subject invention as recited in claims 1-3.

> To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness. A *prima facie* case of obviousness is established by a showing of three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the *prior art reference (or references when combined) must teach or suggest all the claim limitations*. *See* MPEP §706.02(j). The teaching or suggestion to

> make the claimed combination and the reasonable expectation of success must both be found in the prior art and *not based on applicant's disclosure. See In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Emphasis added.

In particular, the combination of Hudetz, *et al.* and Powell does not teach or suggest providing demographic information about a customer to a product manufacturer by utilizing the information inquiry, as recited in claim 1. The present invention, as claimed, relates to a system for automated remote retrieval and display of product specific information, including a bar code reader for scanning uniform product code information, which is then decoded to permit immediate and automated access to product-specific information that is communicated to and displayed on a user terminal (See generally Abstract). Accordingly, a fast, easy-to-use mechanism is provided by which manufacturers may supply product information to their consuming public quickly and inexpensively. (p.4, lines 17-19.) This is facilitated by providing demographic information about the consumer to the product manufacturer by utilizing the information inquiry. The Examiner concedes that Hudetz, *et al.* does not disclose providing demographic information about the consumer to the product manufacturer by utilizing the information inquiry. Accordingly, the Examiner relies on the teachings of Powell to make up for the deficiencies of Hudetz, *et al.*

However, Powell fails to overcome the deficiencies of Hudetz, *et al.* Powell suggests the use of consumer identification data that is compiled from electronic coupon redemption statistics, sent to a marketing research center, and used to access the corresponding demographic data, which, ultimately, can be made available to the product manufacturer (Col. 7; lines 1-7). Powell does not utilize an information inquiry made to the product manufacturer to provide demographic information about a consumer, as required by claim 1 of the subject application. The claimed invention does not require external assistance of a marketing research center to provide the product manufacturer with demographic and/or geographic consumer information, but rather, as stated above, provides a system for the retrieval of consumer demographic information gleaned from the consumer's individual and unique Internet query. Powell does not suggest or disclose this limitation.

Furthermore, it cannot be inferred from Powell that the system described therein is capable of providing demographic information to the product manufacturer based on the

consumer's "information inquiry." If Powell describes a system for "inquiring" about a product, the inquiry described therein relates merely to the physical location of a product within the physical space of a retail store. This inquiry is not directed toward the product manufacturer, does not employ the Internet, is not user specific, and, therefore, cannot be used directly by the product manufacturer to obtain demographic information regarding the inquiring consumer. To infer that the Powell system, as described, is capable of providing demographic information directly to the product manufacturer based on a consumer inquiry is to declare such a limitation inherent to that system.

> "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *Mehl/Biophile Int'l Corp. v. Milgraum*, 192 F.3d 1362, 1365, 52 USPQ2d 1303, 1305 (Fed. Cir. 1999), reh'g denied, 1999 U.S. App. LEXIS 31386 (Fed. Cir. Oct. 37, 1999) (*quoting In re Oelrich*, 666 F.2d 578, 581, 212 USPQ323, 326 (CCPA 1981)).

The mere fact that a manufacturer eventually may receive demographic data, via a market research center that tracks coupon redemption, is not sufficient to make the demographic data transmittal element an inherent, let alone explicit, limitation of the Powell reference.

As discussed above, neither Hudetz nor Powell, individually or in combination, disclose or suggest the limitation of utilizing a consumer inquiry directed to the product manufacturer's website to obtain demographic information regarding the consumer. Because Hudetz does not describe each and every element of the present invention, and because Powell fails to overcome the deficiencies of Hudetz, expressly or inherently, Hudetz and Powell cannot properly be combined to render obvious independent claim 1 of the present invention, or claims 2 and 3, which depend there from. Accordingly, withdrawal of this rejection and allowance of claims 1-3 are respectfully requested.

III. Rejection of Claim 4 Under 35 U.S.C. 103(a)

Claim 4 stands rejected under 35 U.S.C. 103 (a) as being unpatentable over Hudetz, *et al.* (U.S. Patent No. 5,978,773) in view of Powell (U.S. Patent No. 5,887,271), and further in view of Kaplan (U.S. Patent No. 5,963,916). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons.

Claim 4 depends from claim 1, which is believed to be in condition for allowance for the aforementioned reasons. Kaplan does not make up for the aforementioned deficiencies of Hudetz, *et al.* and Powell with respect to claim 1, as discussed above. Therefore, claim 4 is not obvious over the combination of Hudetz, *et al.*, Powell, and Kaplan. Accordingly, withdrawal of this rejection and allowance of claim 4 are respectfully requested.

IV. CONCLUSION

The present application is believed to be condition for allowance in view of the above comments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,

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